

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of) Confirmation No. 4758
)
Juliana Parente, et al.) Group Art Unit: 1761
)
Serial No. 10/727,128) Examiner: Pratt, H. F.
)
Filed: December 3, 2003) Atty. Docket No.: 006943.00193

For: IN-LINE PROCESS FOR PREPARING CALCIUM-SUPPLEMENTED JUICE BEVERAGES

PETITION UNDER 37 C.F.R. § 1.59 TO EXPUNGE A DOCUMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants and assignee petition under 37 C.F.R. § 1.59 to expunge a document entitled “Amendment and Response” filed March 12, 2007. Applicants and assignee had no intention to file two responses to the then-outstanding office action. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 1.17(g), and any other fee required to consider this petition and to grant the requested relief, to our Deposit Account No. 19-0733.

Background

This petition to expunge is made on behalf of the Applicants and the assignee. The petition is ripe for consideration, as the only claims pending (after the amendment filed herewith) are allowable.

On March 12, 2007, Applicant unintentionally submitted two responses to the then-pending office action. Applicants seek to expunge the later-filed response. This later-filed response, entitled “Amendment and Response” and executed by Adrian Pishko, was filed after the intended response already had been filed. The first-filed response was entitled “Response” and was executed by the undersigned.

That a second response had been filed became known to the undersigned only after the “Response” had been. Therefore, on March 14, 2007, the undersigned contacted Examiner

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Helen Pratt to inform her of the later filing and to inform her that this filing was not intended to be a supplemental response or a replacement for the first-filed response. Examiner Pratt continued examination based on the claims and argument set forth in the document entitled “Response.”

Discussion

Applicants respectfully submit that the conditions set forth in 37 C.F.R. § 1.59 and MPEP § 724 for expungement of this second-filed response are met herein. Applicants did not intend to file two responses, a supplemental response, or a replacement response. The information in the document did not form a part of the original disclosure (37 C.F.R. § 1.59(a)(2)), and so can be expunged under this rule (37 C.F.R. § 1.59(b)). Further, this document was not submitted as part of an information disclosure statement.

Applicants respectfully submit that this document meets the criteria for expungement under the guidelines set forth in 37 C.F.R. § 724.05(II), as follows:

(A) The office can affect return of the “Amendment and Response” filed March 12, 2007, document prior to the issuance of any patent on the application. By amendment filed herewith, Applicants have cancelled rejected claims, leaving only allowable claims pending in the application. Applicants expect to receive a Notice of Allowability thereafter. There is sufficient time for the office to return the expunged document before issuance of the patent.

(B) The information to be expunged was submitted only after another response had been filed. A response already had been filed, and this later-filed response was not intended to supplement or replace the first. There was no intent to file two responses to the then-pending office action.

To leave this information in the application prosecution history would cause irreparable harm to the applicants and assignee. This document will confuse those who

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review the prosecution history because it will appear that a second response, perhaps in the form of an amendment or supplement to the first response, had been filed. The prosecution history will be unclear and misleading, and thus lack clarity. This unclarity, misleading nature, and lack of clarity of the prosecution history will exist throughout the period of enforcement of any patent, to assignee's continuing detriment and harm.

- (C) The "Amendment and Response" has not otherwise been made public.
 - (D) The "Amendment and Response" will be retained for the period of any patent with regard to which such information is submitted.
 - (E) Applicants respectfully submit that the "Amendment and Response" is not material under 37 C.F.R. § 1.56. It was not considered by the examiner during prosecution.
 - (F) The petition fee under 37 C.F.R. § 1.17(g) is included with this petition by authorization to the Commissioner to charge this fee to our Deposit Account, No. 19-0733.
- Therefore, Applicants respectfully submit that the "Amendment and Response" executed by Adrian Pishko and filed on March 12, 2007, after the "Response" executed by the undersigned was filed, is an expungeable document under 37 C.F.R. § 1.59, in accordance with the guidelines set forth in MPEP § 724.05(II).

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Conclusion

Applicants did not intend to file two responses, or a response and a supplemental response, on March 12, 2007. This material formed no part of the original disclosure or of an Information Disclosure Statement, and was not relied upon by the examiner. This document therefore is expungeable under 37 C.F.R. § 1.59(b), and applicants and assignee petition for its expungement from the record of this application.

Respectfully submitted,

Date: October 19, 2007

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